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CHARLES ELMORE CROPLEY

Supreme Court of the United States

October Term, 1949.

No. 765

FRANCIS H. MONTMARQUET, d/b/a
O. C. MANUFACTURING COMPANY,

Petitioner,

—against—

JOHNSON & JOHNSON,

Respondent.

PETITION FOR WRIT OF CERTIORARI

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O. C. MANUFACTURING COMPANY,

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—against—

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Respondent.

PETITION FOR WRIT OF CERTIORARI

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Francis H. Montmarquet, doing business as the O. C. Manufacturing Company, respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Third Circuit entered January 23, 1950.

A certified transcript of the record in the case including the proceedings in the Court of Appeals for the Third Circuit is furnished herewith in compliance with Rule 38 of this Court.

Summary Statement of Matter Involved

Petitioner sued respondent in the United States District Court for the District of New Jersey for infringement of

United States Letters Patent No. 2,301,066 issued to petitioner on November 3, 1942 for an athletic supporter.

After filing of an answer and counterclaim for declaratory judgment (6a)* and after petitioner's reply to the counterclaim (12a), respondent moved under Rule 56** of the Federal Rules of Civil Procedure for a summary judgment holding the patent invalid and not infringed (13a). Respondent, in support of the motion relied upon the pleadings and proceedings theretofore had and upon the file wrapper of the patent in suit (14a). The District Judge granted respondent's motion in an opinion stating that the facts were clear and uncontroverted and upon the theory that all the physical evidence material to a decision was in the record (25a).

Actually in so doing, as will hereinafter appear, the District Court summarily disposed of a genuine issue as to a material fact; and involved here is an important question of procedure under Rule 56 of the Federal Rules of Civil Procedure heretofore undecided by this Court.

The District Court held the patent invalid on the ground that it was anticipated (39a) by a British patent to Cartledge, No. 494,393 (61a). This patent was a reference over which the Patent Office had allowed the patent at bar to issue (35a).

As a subsidiary reason for the finding of invalidity, the Court held that petitioner's patent lacked invention (39a) over Johnson patent No. 1,155,659 (60a) issued in 1915.

The District Judge also held that because petitioner's patent was invalid, it could not be infringed (42a).

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* We shall refer to the transcript of record by page number with the character "a" appended thereto to indicate that the page is in the appendix attached to the brief of appellant before the United States Court of Appeals for the Third Circuit.

** The pertinent portions of Rule 56 are set out at pages 5-6.

Petitioner's patent is for an athletic supporter, better known as a "jock strap". The patented supporter includes a belt, and a pouch which depends from the lower front edge of the belt. The part of the belt to which the upper edge of the pouch is attached consists of two overlapping angular sections. These overlapping sections have a common, single, lower edge which is substantially horizontal. To this common edge at the bottom of the belt the upper edge of the pouch is attached. The combined pouch and belt as described have the effect of cupping the pouch into form-fitting position [Montmarquet patent (58a) p. 2, col. 1, line 50 *et seq.* and p. 2, col. 2, line 2 *et seq.*], and also tends to maintain the belt in position even after violent exercise without discomfort to the wearer [Montmarquet patent (58a) p. 2, col. 1, lines 55-73].

The claimed novel feature of petitioner's patent resides in the foregoing overlapped angular sections with the common horizontal bottom edge to which the upper edge of the pouch is attached.

The British Cartledge patent includes a belt and a pouch. In the drawings of this patent (64-1/2a) the front of the belt is not shown to have any overlapping angular sections. The only common edge disclosed in the British patent is the vertical meeting edge of the ends of the belt referred to in the patent as "the joint 2". This edge is not attached to the pouch. In the description of the patent, the following language appears (62a):

> "Of course, joint 2 need not necessarily be the ends of the band, for, though not preferred, the angle may be provided by a fold while the ends may meet anywhere [60] around the body."

The District Court in holding petitioner's patent invalid over the British patent interpreted this language to mean

the provision of a fold "identical with" petitioner's (38a). Both the Commissioner of Patents and petitioner's affidavit hereinafter referred to (petitioner is qualified in the affidavit as an expert in the field) are in disagreement with the District Court's interpretation of the above quoted language of the British patent.

The Johnson patent is for a catamenial belt. The front of the belt includes crossed angular portions similar to those in the belt front of the petitioner's patent. The Johnson patent has no pouch. The belt front of the Johnson patent is designed to be attached by a safety pin to one end of a sanitary napkin. There is no reason or purpose for this belt to shape the napkin and, even if there were, the interpositioning of the safety pin would prevent such shaping.

After the Court handed down an opinion in respondent's favor, petitioner moved for reargument and submitted two supporting affidavits, one by petitioner and the other by a duly registered physician, Dr. Mabee.

Petitioner's affidavit (43 a-2) pointed out that the fold mentioned in the British patent is a vertical fold which does not result from overlapping of the material of the belt and which serves the same purpose as and is a modified form of the vertical seam or joint 2. In other words, according to the affidavit, this modification referred to in the quoted language, like the joint 2, did not suggest or serve the purpose of petitioner's angular overlapped sections having a horizontal bottom edge to which the pouch is attached.

Petitioner's affidavit also stated that the function of an athletic supporter was to press against the body so as to give a lifting and supporting action; whereas in a catamenial supporter (the Johnson patent), pressure against the body was positively to be avoided. Dr. Mabee's affi-

davit stated that the function of a catamenial support was not to lift a sanitary napkin into contact with the body, but rather to minimize such force as much as possible.

Under these circumstances, in granting the motion for summary judgment and holding petitioner's patent invalid for lack of invention over the Cartledge patent and the Johnson patent, the District Court decided a genuine issue of a material fact contrary to the provisions of Rule 56.

The Court of Appeals on January 23, 1950 affirmed the judgment of the District Court upon the opinion below without a discussion of the facts or of the law.

Involved Here Is a Question of Procedure Under Rule 56 of the Federal Rules of Civil Procedure

The pertinent portions of Rule 56 as it existed at the time the motion was made on January 15, 1948 read as follows:

> Rule 56. Summary Judgment.
>
> * * * * *
>
> (b) For Defending Party. A party against whom a claim, counterclaim, or cross-claim is asserted or a declaratory judgment is sought may, at any time, move with or without supporting affidavits for a summary judgment in his favor as to all or any part thereof.
>
> (c) Motion and Proceedings Thereon. The motion shall be served at least 10 days before the time specified for the hearing. The adverse party prior to the day of hearing may serve opposing affidavits. The judgment sought shall be rendered forthwith

if the pleadings, depositions, and admissions on file, together with the affidavits, if any, show that, except as to the amount of damages, there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.

* * * * *

Jurisdiction of This Court

Jurisdiction of this Court is invoked under the Judicial Code, Title 28, Section 1254 (1).

The Judgment of the United States Court of Appeals for the Third Circuit which petitioner seeks to have reviewed was entered on January 23, 1950.

The Questions Presented

The questions petitioner seeks to have reviewed by this Court are:

1. Is not a genuine issue of fact decided in violation of section (c) of Rule 56 of the Federal Rules of Civil Procedure when a court on motion for summary judgment invalidates a duly issued United States Letters Patent for lack of invention over prior art, there being a contest on that issue?

2. Is not a genuine issue of fact decided in violation of section (c) of Rule 56 of the Federal Rules of Civil Procedure when a court on motion for summary judgment invalidates a duly issued United States Letters Patent as anticipated by a file wrapper reference, there being a contest on that issue?

Reasons Relied on for Allowance of the Writ

1. The Court of Appeals has decided an important question of Federal law on which there are conflicting decisions by Circuit Courts of Appeals and by District Courts.

2. The Court of Appeals has decided an important question of Federal law which has not been, but should be, settled by this Court.

Prayer

Wherefore your petitioner respectfully prays that a Writ of Certiorari be issued to the Court of Appeals for the Third Circuit to the end that this cause may be reviewed and determined by this Court and that your petitioner may have such other and further relief in the premises as to this Court may seem meet and just.

Morris Kirschstein,
Attorney for Petitioner.

Supreme Court of the United States

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No.

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BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

The opinion of the United States District Court for the District of New Jersey is reported in 82 F. Supp. 469.

The opinion of the Court of Appeals for the Third Circuit is reported in 179 F. 2nd 240.

Jurisdiction

Jurisdiction of this Court is invoked on the grounds set forth in the accompanying petition for Writ of Certiorari.

Statement of the Case

The essential facts of the case are stated in the accompanying petition for Writ of Certiorari.

Specification of Errors

The error which petitioner will urge, if this Writ of Certiorari is issued, is that the Court of Appeals for the Third Circuit erred in affirming the District Court upon the opinion of the District Court and in thereby holding:

1. That the patent at bar could be invalidated without passing upon a genuine issue as to a material fact; and

2. That the complaint should be dismissed.

ARGUMENT

I.

The Court of Appeals has decided an important question of Federal Law on which there are conflicting decisions by Circuit Courts of Appeals and by District Courts.

The Court summarily held petitioner's patent invalid for lack of invention in view of prior art. The issue of validity of a patent over the art when tested by the presence or absence of patentable novelty is one of fact. (*Graver Tank & Mfg. Co.* v. *Linde Air Prod. Co.*, 93 L. ed. 492.)

Yet there is a conflict of decisions in the Federal Courts as to whether the question of validity of a patent for lack of invention over the prior art presents a genuine issue of fact such as to bar summary disposition.

Some courts have definitely held they will not grant summary judgment in such cases. Others have granted them.

The weight of authority is against granting them because the courts zealously guard a litigant's right to his day in court.

In the following cases the courts have refused to grant motions for summary judgments ~~dismissing~~ INVALIDATING patents for lack of patentable novelty over the prior art:

Bowers v. *E. J. Rose Mfg. Co.*, 149 F. 2d 612 C. C. A. 9.

"Even assuming there were such a conversion to a trial by affidavits in a case where, as here, the issues are clearly drawn in the pleadings, the juridical function exercised by the court in determining anticipation on the evidence in affidavits is in an action tried upon the facts upon which a final judgment is determined, and hence requiring findings of fact and conclusions of law thereon under Federal Rules of Civil Procedure.[2] None was made.

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2 Rule 52. Findings by the court.
(a) Effect. In all actions tried upon the facts without a jury, the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment; * * *." (Page 616)

Weil v. *N. J. Richman Co.*, 34 F. Supp. 401, D. C., S. D. New York.

"The various facts affecting patentability cannot adequately be dealt with except after proof at the final hearing. (Citing a case)" (Page 402)

Engineering Specialties Co. v. *Burgess Battery Co.*, 40 F. Supp. 1014, D. C., S. D. New York.

"Plaintiff's patent has never been adjudicated and the fact that certain references herein were before the

Patent Office lends greater presumptive force to the issuance of said patent. (Citing a case). In view of this presumption of validity of plaintiff's patent, defendant's contention that said patent does not evidence sufficient improvement over the prior art to constitute invention should be resolved upon a trial wherein experts of both parties may be subjected to cross-examination. (Citing cases)" (page 1015)

Baker v. *First Nat. Stores,* 64 F. Supp. 979, D. C., D. Massachusetts.

"Since the Patent Office has granted a patent on this device there is at least some color of patentable invention, and the plaintiff is entitled to his day in court on these issues. Patent validity is an issue not rightly disposed of by summary judgment. (Citing a case)" (page 980)

See also:

Refractolite Corporation v. *Prismo Holding Corporation,* 25 F. Supp. 965, D. C., S. D. New York;
Bliss Co. v. *Cold Metal Process Co.,* 47 F. Supp. 897, 899, D. C., N. D. Ohio, E. D.
American Optical Co. v. *New Jersey Optical Co.,* 58 F. Supp. 601, 605, D. C., D. Massachusetts.

In the following cases courts have granted motions for summary judgment for lack of patentable novelty over the prior art:

Davison Chemical Corp. v. *Joliet Chemicals,* 179 F. 2d 793 C. C. A. 7.

"His prescription for that process, we have held, did not constitute invention. We are unable to find re-

maining any genuine issue of fact between plaintiff and defendants. Consequently, the court rightfully allowed the motion for summary judgment. Such practice in similar cases is not new. (Citing cases)" (page 795)

See also:

Juniper Mills v. *J. W. Landenberger & Co.*, 6 F. R. D. 463, D. C., E. D. Pennsylvania.

We do not include, because outside the conflict of authority, those cases where a motion for summary judgment of patent invalidity was granted on purely legal grounds such as failure to disclaim, etc., since in these cases there is no genuine issue of fact.

II.

The Court of Appeals has decided an important question of Federal Law which has not been, but should be, settled by this Court.

The question of whether summary judgment may be granted under Rule 56 holding a patent invalid for lack of patentable novelty over the prior art appears never to have been decided by this Court. The circuit courts of appeal and the district courts are in conflict on this issue. What is involved is a matter of procedure vital to the administration of justice in the federal courts with particular reference to the Patent Statutes. What is here challenged basically, is the right of a district court to decide under Rule 56 a genuine issue of fact.

The District Court here misconstrued its function. It is for a district court sitting in Trial Term to assess the

evidence and decide issues of fact. When sitting in Motion Term the court's function under Rule 56 is only to determine if a genuine issue of fact is presented. Once such an issue is found to exist, as was the case here, the district court must deny the motion for summary judgment so that the issue may be tried.

On such motion the District Court's opinion as to how the issue ultimately should be resolved is not material; for unless the issue is frivolous a litigant is entitled to his day in court (*Fidelity & Deposit Company of Maryland* v. *United States,* 187 U. S. 315, 320). Were the law otherwise, a court could always on summary motion substitute its opinion for that of the trier of the facts. The absurd result then would follow that even where, as here, there is a sharp conflict in the evidence as to a genuine issue of fact, a court on motion for summary judgment, having reached an opinion as to how the issue *should* be decided were the case before it at Trial Term, would so decide that issue and terminate the litigation without actual trial.

If such procedure should be sanctioned the rule would become a vice instead of a virtue. For with the desire of courts to clear calendars, it is not inconceivable that many a district court mistaking its role under Rule 56 will decide genuine issues of fact on motions for summary judgment.

Respectfully submitted,

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